

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-6 are pending in the application, with claim 1 being the independent claim. Claims 1 and 2 have been amended to recite the amount of compound applied. New claims 3-8 are sought to be added. Support for the amendments to claims 1 and 2 and for new claims 3-8 can be found in the specification as filed at, *e.g.*, page 34, lines 16-23 and page 36, Table A. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Double Patenting Over Co-pending Application No. 10/591,674

The Examiner has maintained the provisional rejection of claim 1 on the grounds of non-statutory obviousness-type double patenting over claim 4 of co-pending Application No. 10/591,674 ("the '674 application"). Applicants respectfully traverse this rejection as it pertains to the current claims.

First, Applicants note that this rejection is provisional and request that the Examiner hold this rejection in abeyance until allowable claims are identified in the '674 application.

Obviousness-type double patenting is a judicially created doctrine that "prohibit[s] a party from obtaining an extension of the right to exclude through claims in a later patent that are not patentably distinct from claims in a commonly owned earlier patent." *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001). There

are two steps in an obviousness-type double patenting analysis. First, one "construes the claim[s] in the earlier patent and the claim[s] in the later patent and determines the differences." *Id.* at 968. Second, one determines whether those differences render the claims patentably distinct. *Id.* "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim." *Id.*

Claim 4 of the '674 application claims is generally directed to the use of a combination of herbicide compounds to control unwanted plants. In contrast, the present claims are directed specifically to controlling *Apera* using the compound of formula I in an amount of 2-60g a.i./ha. Thus, Applicants respectfully assert that this rejection is unfounded because: (i) the current claims are not drawn to a combination of herbicides; and (ii) the current claims specifically recite controlling *Apera* with a specified amount of the herbicide recited in the claims. There is nothing in the claims of the '674 application that would lead one of ordinary skill in the art to choose the specific compound of the present claims in the recited amount for use specifically for controlling *Apera*.

Reconsideration and withdrawal of this rejection is respectfully requested.

Double Patenting Over U.S. Patent No. 6,964,939

The Examiner has also maintained the rejection of claim 1 on the grounds of non-statutory obviousness-type double patenting over claim 3 of U.S. Patent No. 6,964,939 ("*Gesing et al.*"). Applicants respectfully traverse this rejection as it pertains to the current claims. Applicants respectfully assert that this rejection is unfounded as it pertains to the current claims, because the claims of *Gesing et al.* would not lead a

person of ordinary skill in the art to use the claimed compound in the recited amounts especially on *Apera*.

Claim 3 of Gesing *et al.* is generally directed to controlling undesirable vegetation, comprising allowing a compound of formula I to act on the undesirable vegetation. In contrast, pending claim 1 specifically recites the control of *Apera* by applying a compound of formula I in an amount of 2-60g a.i/ha. Nothing in claim 3 of Gesing *et al.* would lead a person of ordinary skill in the art to the use the claimed compound in the specified amount specifically on *Apera*. In addition, Applicants have surprisingly found that the compound of formula I is extremely effective against *Apera* even at the low concentration recited in the current claims relative to other unwanted vegetation. Specifically, as evidenced by the data presented below and in the Declaration Under 37 C.F.R. § 1.132 ("the Declaration") filed on August 1, 2008, the compound of formula I effectively eradicates the weed *Apera* while having little to no impact on the surrounding crop plants, even when applied in connection with a safener, such as mefenpyr-diethyl.

| Plant Variety | Compound I (g ai/ha) | Mefenpyr-diethyl (g ai/ha) | Damage (%) |
|-------------------------------|-------------------------|-------------------------------|------------|
| <i>Apera spica-venti</i> | 7.5 | 22.5 | 97 |
| <i>Alopecurus myosuroides</i> | 7.5 | 22.5 | 57 |
| <i>Phalaris spp.</i> | 7.5 | 22.5 | 43 |
| <i>Poa annua</i> | 7.5 | 22.5 | 15 |

These data were obtained under conditions identical to those described at page 35, line 4, through page 36, line 5 of the application as filed. Moreover, the data

provided in Table A (page 36 of the application as filed) indicate that applying the compound of formula I in the claimed amounts effectively eradicates the weed *Apera* while having little to no impact on the surrounding crop plants, causing only 4% crop damage, even when applied in connection with a safener, such as mefenpyr-diethyl.

One of ordinary skill would not have expected that the specifically claimed compound of formula I applied at the claimed amounts would be so effective at specifically controlling *Apera* from the teachings of claim 3 of Gesing *et al.*

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

The Examiner has also maintained the rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as obvious in view of Gresling *et al.* Applicants respectfully traverse this rejection as it pertains to the current claims.

Applicants maintain that there is nothing in Gesing *et al.*, the knowledge in the art, and the nature of the problem to be solved, that would lead a person of ordinary skill in the art to use the claimed compound of formula I in the recited amount especially to control *Apera* as claimed in the present application.

Gesing *et al.* discloses generally a method of controlling unwanted vegetation by applying the compound of formula I to that vegetation. However, as the Examiner notes, "Gesing *et al.* do not teach an exemplification of the instant compound being applied to the *Apera* species." In contrast to Gesing *et al.*, the present invention is directed to specifically controlling *Apera* using the compound of formula I in the recited amounts. Accordingly, a *prima facie* case of obviousness has not been established. Withdrawal of this rejection is respectfully requested.

Even if the Examiner has properly establish a *prima facie* case of obviousness over the cited art against the currently pending claims, which Applicants respectfully assert she has not, the presently claimed method shows a surprisingly effective result even when the claimed compound is applied to *Apera* at low concentrations. In fact, as evidenced at page 35, line 4, through page 36, line 5 of the application as filed, and in the Declaration filed August 1, 2008, the claimed compound I effectively eradicates the weed *Apera* while having little to no impact on the surrounding crop plants, even when applied in connection with a safener, such as mefenpyr-diethyl. Moreover, Applicants have surprisingly found that the claimed compound I is effective specifically against *Apera* when used at low concentration, *e.g.*, 7.5 g ai/ha and 15 g a.i./ha. (*See, e.g.*, page 36, Table A.) In contrast, the data in Gesing *et al.* was obtained with application rates of 60 g ai/ha. It is absolutely unexpected that decreasing the application rate of the compound of formula I taught in Gesing *et al.* by a factor of 8 (7.5 g ai/ha versus 60 g ai/ha) would result in extremely effective weed control of the species *Apera* compared to other weed species. This surprising result was not suggested and would certainly not be expected from the disclosure of Gesing *et al.* This unexpected result renders the currently claimed method non-obvious.

Reconsideration and withdrawal of the outstanding rejection is earnestly solicited.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the

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Reply to Office Action of November 14, 2008

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outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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